

REMARKS

INTRODUCTION:

In accordance with the foregoing, reconsideration is respectfully requested. No new matter is being presented, and approval and entry are respectfully requested.

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response and Request for Reconsideration because:

(a) it is believed that all outstanding rejections for claims 1-15 have been overcome and/or rendered moot, thereby putting this application into condition for allowance.

(b) new claims 16-17 should not entail any further search by the Examiner since no new features are being added and no new issues are being raised;

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTION UNDER 35 U.S.C. §102(b):

On page 2, item 5, of the Office Action, the Examiner rejects claims 1-3, 8, 11, and 13-15 under 35 U.S.C. § 102(b) as being anticipated by Watanabe (U.S. Patent No. 5,499,252). The Applicant respectfully traverses the rejection and requests reconsideration and allowance of the claims.

Watanabe is directed towards a CD-ROM decoder for correcting code errors of the digital data that is read from a recording medium. In particular, Watanabe discloses having sub-code data and CD-ROM code sent from a digital signal processor 11 to a buffer RAM 18 via a decoder 12. The sub-code data is read by a sub-code reading circuit 16 of the decoder 12 and then stored in the buffer RAM 18. The CD-ROM code is stored in the buffer RAM 18 and then sent to an error-correcting portion 14 of the decoder 12 to be error corrected and then sent back to the buffer RAM 18. Upon an instruction by the host computer, the read sub-code data and the corrected CD-ROM code is transmitted from the buffer RAM 18 via a host interface 15 to the

host computer 19. Watanabe, FIG. 1, column 4, lines 46-61.

Independent claim 1 of the present application recites: "A method of providing sub-code data to a host computer ... comprising ... setting the sub-code data whenever the data of a predetermined unit is output from a buffer ..."

Watanabe does not teach or suggest "**setting the sub-code data** whenever the data of a predetermined unit is output from a buffer," as is recited in claim 1 of the present application. Instead, Watanabe discloses transmitting and storing sub-code data in a buffer 18 that is read by a sub coding reading circuit 16 of a decoder 12. The same sub-code data that is read by the sub-code reading circuit 16 of the decoder 12 and stored in the buffer RAM 18 is also output from the buffer RAM 18 to the host computer 19 upon a command. Watanabe, FIG. 1, column 4, lines 46-61. Therefore, the sub-code data in Watanabe is not **set** whenever the data is output from the buffer. In fact, Watanabe does not disclose doing anything with the read sub-code data that is stored in the buffer other than outputting the sub-code data directly to the host computer along with the corrected CD-ROM data.

Further, Watanabe does not disclose setting or even outputting the read sub-code data **whenever** the data of a predetermined unit is output from a buffer. Instead, Watanabe discloses "an error correcting circuit for reading from the memory the ROM data which is written by the input interface circuit, detecting and correcting code errors included in the ROM data, and writing the correct data into the memory." Watanabe, column 3, lines 1-10. In other words, the code of the CD-ROM data is outputted from the buffer RAM 18 to an error-correcting portion 14 of the decoder 12 to be error corrected and then the corrected code of CD-ROM data is sent back to the buffer RAM 18. No sub-code data is set when the code of the CD-ROM data is output from the buffer; therefore, the sub-code data in Watanabe is not set **whenever** data is output from the buffer.

While "official notice" may be relied upon, as noted in MPEP §2144.03, these circumstances should be rare when an application is under final rejection or action under 37 CFR §1.113. Official Notice unsupported by documentary evidence should be only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known and only when such facts are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection.

Applicant disagrees with the Examiner's assertion that "... the sub-code will be adjusted, changed and corrected whenever data is output from buffer RAM 18. This feature is equivalent with 'setting sub-code' as claimed." Final Office Action mailed June 23, 2004, page 3, paragraph 7. Although Watanabe discloses outputting sub-code data from a buffer to a host computer, Watanabe does not disclose that the sub-code data will be adjusted, changed, and corrected whenever data is output from the buffer and the Examiner offers no support for this assertion. To the contrary, Watanabe specifies that the control microcomputer 17 for controlling the operations of the decoder need not deal with the sub-code data; therefore, once the sub-code data is read and stored in the buffer RAM 18, the sub-code data is not "adjusted, changed, and corrected" when it is output with the corrected code of the CD-ROM data to the host computer 19. Watanabe, column 5, lines 28-32. Further, Applicant disagrees that the Examiner's assertion that the function of "adjusted, changed, and corrected" sub-code data is equivalent to "setting" sub-code data. These words have very different meanings as related to sub-code data. Since the Examiner's assertion is not well known or of common knowledge in the art, the Examiner must provide an evidentiary showing to support such a rejection.

Accordingly, the Applicant respectfully requests reconsideration and allowance of claim 1.

Each of independent claims 13 and 14 recites setting sub-code data in response to data being read from a buffer. As discussed above, Watanabe does not disclose or suggest such a feature. Therefore, for at least the reasons stated above with respect to claim 1, each of claims 13 and 14 patentably distinguishes over Watanabe and is therefore in condition for allowance.

Claim 15 recites setting sub-code data based on the output of a buffer. As detailed above, Watanabe does not disclose or suggest such an element. Therefore, for at least the reasons stated above with respect to claim 1, claim 15 patentably distinguishes over Watanabe and is therefore in condition for allowance.

Each of claims 2, 3, 8, and 11 depends from independent claim 1. Accordingly, the Applicant submits that each of these claims patentably distinguishes over Watanabe for at least the same reasons as independent claim 1, as well as for any additional features they recite.

REJECTION UNDER 35 U.S.C. §103(a):

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against

the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Applicant respectfully submits that independent claim 12, similarly to claim 1, recites **setting** a current item of sub-code data in response to data being read from the buffer. As previously discussed, Watanabe does not disclose or suggest setting sub-code data in response to anything being read from a buffer. Instead, Watanabe discloses transmitting and storing sub-code data in a buffer 18 that is read by a sub coding reading circuit 16 of a decoder 12. The same sub-code data that is read by the sub-code reading circuit 16 of the decoder 12 and stored in the buffer RAM 18 is also output from the buffer RAM 18 to the host computer 19 upon a command. Watanabe, FIG. 1, column 4, lines 46-61. Therefore, the sub-code data in Watanabe is not **set** in response to data being read from the buffer. In fact, Watanabe does not disclose doing anything with the read sub-code data that is stored in the buffer other than outputting the sub-code data directly to the host computer along with the corrected CD-ROM data. Therefore, the Applicant submits that claim 12 is patentably distinct over Watanabe and requests reconsideration and allowance of the claim.

Each of claims 4-7, 9, and 10 depends from independent claim 1. Accordingly, the Applicant submits that these claims are patentably distinct over Watanabe for at least the same reasons as their base claim, as well as for any additional features they recite.

NEW CLAIMS 16 AND 17:

Claims 16 and 17 are newly added claims that are completely supported by the original Specification and patentably distinguish over the references relied upon by the Examiner.

Claim 16 is drawn to a method of providing virtual sub-code data to a host computer including: “ ... setting the **virtual sub-code data** whenever the data of a predetermined unit is output from the buffer ...” (emphasis added) The prior art reference relied upon by the Examiner, Watanabe, does not disclose setting virtual sub-code data. Instead, Watanabe discloses transmitting actual sub-code data from a sub-code reading circuit 16 of a decoder 12 to a buffer RAM 18 and then outputting the same actual sub-code data with corrected code of CD-ROM data to a host computer 19. Watanabe, FIG. 1, column 4, lines 46-61. Therefore, for at least this reason, Applicant respectfully asserts that new claim 16 is in condition for allowance.

Claim 17 is drawn to a method of providing sub-code data to a host computer including: “... **incorporating** the sub-code data whenever the data of a predetermined unit is output from

the buffer ..." (emphasis added) The prior art reference relied upon by the Examiner, Watanabe, does not disclose incorporating the sub-code data whenever the data of a predetermined unit is output from the buffer. Instead, Watanabe discloses outputting sub-code data from a buffer RAM 18 to a host computer 19. Watanabe, FIG. 1, column 4, lines 46-61. Therefore, unlike the present application, the sub-code data that is outputted from the buffer RAM is already present in the buffer RAM prior to such outputting. Therefore, for at least this reason, Applicant respectfully asserts that new claim 17 is in condition for allowance.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the references relied upon by the Examiner. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: August 23, 2004

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